

## **REMARKS**

### **Information Disclosure Statement**

Applicant is hereby submitting an information disclosure statement.

### **Objection to the Specification and Drawings**

The Examiner requested correction of certain errors in the specification and drawings. In response, Applicant has amended the specification and Figure 1. No new matter has been added.

### **Rejections under 35 U.S.C. § 102(b)**

Claims 1, 2, 6, 15, 16, 22, 25, 28, 40, 41, 42, 52, 54, and 55 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 5,598,474 by Johnson. Applicant respectfully submits that Johnson does not disclose each and every element of the invention as claimed in claims 1, 2, 6, 15, 16, 22, 25, 28, 40, 41, 42, 52, 54, and 55. Johnson calculating a cryptographic number from a biological part, such as a fingerprint, and encoding the number onto the magnetic strip of a card. Johnson does not disclose writing the cryptogram onto the card after the user has taken possession of the card, as claimed.

Accordingly, Applicant respectfully submits that claims 1, 2, 6, 15, 16, 22, 25, 28, 40, 41, 42, 52, 54, and 55 are not anticipated by Johnson under 35 U.S.C. § 102(b) and respectfully requests the withdrawal of the rejection.

### **Rejections under 35 U.S.C. § 103**

#### **Claims 3, 5, 7-14, 36-39, 43, 50, 53, and 56-58**

Claims 3, 5, 7-14, 36-39, 43, 50, 53, and 56-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of U.S. Patent Number 6,289,323 by Gordon, dated Sep. 11, 2001. Applicant does not admit that Gordon is prior art and reserves the right to swear behind the reference at a later date. Regardless, Applicant respectfully submits that the combination of Johnson and Gordon does not disclose all elements recited in Applicant's claims, and therefore the Examiner has failed to state a prima facie obviousness argument.

As discussed above, Johnson does not teach or suggest all elements in Applicant's independent claims. Gordon does not teach or suggest the claim elements missing in Johnson. Gordon discloses conducting secure transactions via postal authority cryptographic transformations. Gordon discloses issuing a monetary amount value, in the form of a value message including a cryptographic transformation, to a recipient who applies additional cryptographically transformed information to endorse the value message. The postal authority receives the endorsed value message, cryptographically transforms the value message, and registers the transfer of the monetary amount value from the payor to the payee. Gordon does not teach or suggest writing a cryptogram on to a card after the user has taken possession of the card, as claimed.

Neither Johnson nor Gordon teaches writing the cryptogram on to the card after the user has taken possession of the card, as claimed in independent claims 1, 8, 15, 44, 51, and 54. Since claims 3, 5, 7-14, 36-39, 43, 50, 53 and 56-58 depend from and include the limitations of one of independent claims 1, 8, 15, 44, 51 and 54, the combination cannot be interpreted to render obvious Applicant's invention as claimed in claims 3, 5, 7-14, 36-39, 43, 50, 53 and 56 - 58. Accordingly, Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination.

#### Claims 17-19 and 24

Claims 17-19 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of U.S. Patent Number 6,314,196 by Yamaguchi, dated Nov. 6, 2001. Applicant does not admit that Yamaguchi is prior art and reserves the right to swear behind the reference at a later date. Regardless, Applicant respectfully submits that Applicant's invention as claimed in claims 17-19 and 24 is not obvious over this combination because Johnson and Yamaguchi together do not disclose or suggest all elements in these claims.

Yamaguchi discloses only checking fingerprints by registering fingerprint data derived from extraction of minutiae from a fingerprint. The registered fingerprint data is compared with stored fingerprint data and if there is a match, a user is authenticated.

Yamaguchi does not teach or suggest writing a cryptogram on to a card after the user has taken possession of the card as claimed.

Since neither Johnson nor Yamaguchi teaches writing the cryptogram on to the card after the user has taken possession of the card, as claimed in claims 17-19 and 24, the combination cannot be interpreted to disclose the claimed element. Therefore, the combination cannot render obvious Applicant's invention as claimed in independent claim 15. Since claims 17-19 and 24 depend from and include the limitations of claim 15, the combination cannot be interpreted to render claims 17-19 and 24 obvious. Accordingly, Applicant respectfully requests the withdrawal of the rejection over this combination.

#### Claims 20, 21, 23, 26, 27, 29-32, and 44 - 49

Claims 20, 21, 23, 26, 27, 29-32, and 44-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Messmer (Pentagon gets "smart", September 1999). Applicant respectfully submits that this combination does not teach each and every element of these claims. As discussed above, Johnson does not teach or suggest writing a cryptogram onto a card after a user takes possession, and Messmer does not supply this missing element.

Messmer discloses only the use of a chip-based multi-application smart card that allows the holder to sign and encrypt documents and to access networks. Messmer does not teach writing a cryptogram on to a card after the user has taken possession of the card as claimed.

Since neither Johnson nor Messmer teaches writing the cryptogram on to the card after the user has taken possession of the card as claimed in independent claims 15 and 44, the combination cannot be interpreted to render obvious Applicant's invention as claimed in associated claims 20, 21, 23, 26, 27, 29-32, and 45-49. Accordingly, Applicant respectfully requests the withdrawal of the rejection over this combination.

#### Claims 33-35 and 51

Claims 33-35 and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Gordon and in view of Yamaguchi. Applicant

respectfully submits that the combination does not teach each and every element of the invention as claimed in claims 33-35 and 51.

None of Johnson, Gordon, and Yamaguchi teaches writing the cryptogram on to the card after the user has taken possession of the card as claimed in independent claims 15 and 44. Therefore, this combination cannot render obvious Applicant's claims 33-35 and 51, which depend from one of independent claims 15 and 44. Accordingly, Applicant respectfully requests the withdrawal of the rejection over this combination.

### SUMMARY

Claims 1-58 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-8300.

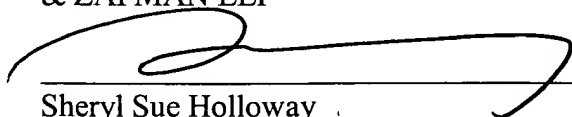
### Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR  
& ZAFMAN LLP

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**In the Drawings**

The attached sheet of drawings includes changes to Figure 1. This sheet replaces the original sheet, including Figures 1 and 2.